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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,300	03/27/2001	Masanori Kawashima	35.C15221	7780
5514 7590 11/01/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER EL CHANTI, HUSSEIN A	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/817,300

**Applicant(s)**

KAWASHIMA, MASANORI

**Examiner**

Hussein A. El-chanti

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12,15-22,25-27,30-32,35,36,39,40,43,44 and 53-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-12, 15-22, 25-27, 30-32, 35-36, 39-40, 43-44 and 53-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to RCE received on August 20, 2007. Claims 1-2, 5-12, 15-22, 25-27, 30-32, 35-36, 39-40, 43-44 and 53-60 are pending examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 11, 20, 26, 31, 35, 39 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 11, 21, 26, 31, 35, 39 and 43 state "displaying step displays the device information corresponding to the item designated in said first designating step and does not display the device information corresponding to the items not designated in said first designating step" and "second designating step to a display target of the device list displayed in said displaying step, in a case where an item not designated in said first designating step is designated in said second designating step" and "a setting step for designating an item to be displayed even though the item has not been designated in said first designating step".

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be

explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-7, 9, 11-12, 15-17, 19, 21-22, 25-27, 30-32, 35-36, 39-40, 43-44 and 53-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Leiman et al., U.S. Patent No. 7,072,067 (referred to hereafter as Leiman).

As to claims 1, 11, 21, 26, 31, 35, 39 and 43, Leiman teaches a network-managing method, device, program and medium for providing a device list with which

device information with regard to a plurality of devices is arranged in order and displayed for every device, comprising:

- a displaying step of displaying the device list (see fig. 6-9);

- a first designating step of designating, from among the plurality of items, an item to be displayed on the device list, wherein, from among the device information included in each record of the device list, said displaying step displays the device information corresponding to the item designated in said first designating step and does not display the device information corresponding to the items not designated in said first designating step (see col. 7 lines 30-43, a dialogue box is displayed to a user to select an option) ;

- a second designating step of designating any one of the plurality of items, wherein, in each record of the device list displayed in said displaying step, a display order is rearranged according to a content of the device information corresponding to the item designated in said second designating step (see col. 7 lines 37-67 and col. 8 lines 30-col. 9 lines 6, the devices are listed according to the user selection); and

- a setting step of setting the item designated in said second designating step as an item to be displayed even though the item has not been designated in said first designating step (see col. 7 lines 37-67),

- wherein said displaying step displays the device list including each record rearranged according to the content of the device information corresponding to the item designated in said second designating step (see col. 7 lines 37-67 and fig. 8-15).

As to claims 2, 12, 22, 27, 32, 36, 40 and 44, Leiman teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a display step of displaying the device list on a display area (see col. 7 lines 37-67 and fig. 8-15).

As to claims 5, 15, 25 and 30, Leiman teaches the method, device, program and medium according to claims 1, 15, 25 and 30 respectively, comprising:

a detection step of detecting a plurality of devices connected to a network; a device information obtaining step of obtaining a device information from a detected a plurality of devices; and a device list generation step of generating a device list data representing the device list based on a obtained device information (see col. 8 lines 30-col. 9 lines 6).

As to claims 6 and 16, Leiman teaches the method according to claims 5 and 15, comprising a storing step of storing obtained device information in a memory area, and, in the device list generation step, generating the device list data based on a device information stored in the memory area (see col. 8 lines 30-col. 9 lines 6).

As to claims 7 and 17, Leiman teaches the method according to claims 5 and 15, comprising: a transmitting step of transmitting a generated device list data to a network; and a display controlling step of analyzing the transmitted device list data and having a display area display the device list (see col. 8 lines 30-col. 9 lines 6).

As to claims 9 and 19, Leiman teaches the method according to claims 8 and 18, wherein the device is a printer (see col. 8 lines 30-col. 9 lines 6).

As to claims 53-60, Leiman teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a judging step wherein in a case where it is judged that the item designated in said second designated step(see col. 7 lines 45-col. 9 lines 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leiman in view of Meyer et al., U.S. Patent No. 6,289,378 (referred to hereafter as Meyer).

As to claims 8 and 18, Leiman teaches a system and method for displaying and modifying a list of devices according to user selected parameters where the list is displayed to the using a browser where the list is transmitted to the network using TCP/IP protocol (see col. 2 lines 50-67).

Leiman does not explicitly teach that the list data is data described in HTML and the list is being transmitted to a network using HTTP protocol. However, Meyer teaches a system and method for obtaining a list of devices on a network using HTML files and sending the list to a network user using HTTP protocol.

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Leiman by creating the device list file using "HTML" since HTML

format is very well known in the art to be a simple language and therefore using HTML would allow the system data to be compatible with a wide range of software programs. Also HTTP is well known protocol in the art to be the main protocol used to transfer HTML data on a network and therefore it would have been obvious for one of the ordinary skill in the art to use HTTP in Leiman to transfer HTML data list on a network because doing so would make Leiman compatible with almost all web browsers.

5. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leiman.

As to claims 10 and 20, Leiman teaches the method according to claims 1 and 11, wherein the device information comprise a device name, device product name, location of device installation (see col. 8 lines 30-col. 9 lines 6).

Leiman does not explicitly teach that the device information also include device MAC address. Official notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to use a MAC address to identify the devices in Leiman's system and method.

Motivation to do so comes from the knowledge well known in the art that using MAC addresses to identify devices would allow the users to communicate with the devices more easily and efficiently, thereby making the system more user friendly.

#### ***Response to Arguments***

6. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Signature: /Hussein El-chanti/

Oct. 24, 2007